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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,093

12/07/2006

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7055 7590 09/23/2008
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EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

NOTIFICATION DATE

DELIVERY MODE

09/23/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/575,093	Applicant(s) MURAKATA ET AL.	
	Examiner SUN JAE Y. LOEWE	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 12, 16, 24, 35, 38, 42, 43, 48, 51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 35, 43, 48 and 51 is/are rejected.
- 7) ☒ Claim(s) 1, 12, 16, 38, 42, 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-26-2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 12, 16, 24, 35, 38, 42, 43, 48, 51 and 53 are pending in the instant application.

Response to Amendment

2. The amendments to the claims filed on August 22, 2008 have been fully considered. The following grounds of objection/rejection have been obviated and are thus hereby withdrawn: a) 35 USC 112 1st paragraph rejection; b) objection to claim 42.

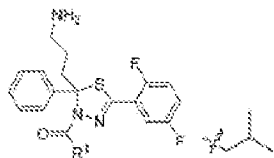
3. The claim amendments do not overcome the objection to the claims for containing non-elected subject matter outside of the originally elected Group I, see below:

Group I, claim(s) 1, 2, 4-19, 23-28 and 34-56 drawn to products of Formula I and process of using products of Formula I, wherein Z=sulfur, R¹=phenyl, R²=C(=W')R¹² with W'=oxygen and R¹²=H or unsubstituted alkyl.

. This ground of objection has been previously made FINAL. Applicant is requested to limit the scope of the claims to the subject matter delineated above. The claims objected to are 1, 16, 24, 38, 42, 43, 48, 51 and 53.

4. The claim amendments necessitated the new ground of rejection set forth herein, Section 8.

5. Notwithstanding the outstanding ground of objection remaining (above), the scope of examination was extended. The non-elected species of



1-(2-(3-aminopropyl)-5-(2,5-difluorophenyl)-2-phenyl-1,3,4-thiadiazol-3(2H)-yl)-3-methylbutan-1-one

which was not

allowable. Therefore, the Markush claims were rejected and non-elected species maintained withdrawn from further consideration.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on August 26, 2008 was filed in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith. The references crossed out were not considered because copies were not provided.

Claim Objections

7. Claims 1, 12, 16, 24, 35, 38, 42, 43, 48, 51 and 53 objected to for containing non-elected subject matter. Currently, non-elected subject matter consists of compounds of Formula I (and methods of using compounds of Formula I) that are not the elected species of Compound 49 (Table 1, page 46). Upon allowance of the generic claims, Applicant will be entitled to rejoinder and examination of non-elected species within the scope of Group I (above, Section 3).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim refers to the terms “as that mentioned above.” Based on this definition, it is unclear what the scope of the claims encompass. Appropriate correction is requested.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 24, 35, 43, 48 and 51 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 7-10, 13, 64 and 91 of copending Application No. 11/252,232. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Determination of the scope and contents of claims 1, 3, 7-10, 13, 64 and 91 of US Appl. 11/252,232.

The claims are drawn to a Markush group of compounds with the same utility as that instantly claimed.

Preferred embodiments disclosed include, for example, the non-elected species shown in Section 5.

Ascertaining the differences claims 1, 3, 7-10, 13, 64 and 91 of US Appl. 11/252,232 and the claims at issue.

The preferred embodiment (above) anticipates the instant claims.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states “...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties”. This is a “Genus-Species Guidelines” for the examination based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

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The preferred embodiment suggests to one of ordinary skill to practice the instant invention. Thus, the instant claims are *prima facie* obvious over claims 1, 3, 7-10, 13, 64 and 91 of copending Application No. 11/252,232.

Conclusion

10. No claims allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./
9-10-2008

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626